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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,960	12/07/2001	Eric Verschuere	214598	7343

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EXAMINER

FUNK, STEPHEN R

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,960

Applicant(s)

VERSCHUEREN ET AL.

Examiner

Stephen R Funk

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mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Claims 5, 11 - 13, 17, 18, 24, 27, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 5, 11 - 13, and 18 the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 7 and 9 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermeersch et al. (EP 802,457) in view of Nussel et al. (US 5,816,161) and Timpe et al. (US 5,698,360). Vermeersch et al. teach the method as recited with exception of treating the recycled substrate with an aqueous acid solution. See the entire document of Vermeersch et al., in particular, column 2 lines 54 - 57, column 4 lines 5 - 10, column 7 lines 4 - 18, and column 10 lines 47 - 51. Nussel et al. teach the conventionality of applying both a cleaning liquid and a refreshing liquid on a reusable substrate. See column 4 lines 3 - 12 of Nussel et al., for example. Timpe et al. teach the conventionality of a refreshing liquid consisting of an aqueous solution of phosphoric acid (which inherently has a pH < 7). See column 7 lines 41 - 51 of Timpe et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of Vermeersch et al. with the step of treating the recycled substrate with an aqueous acid solution in

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view of Nussel et al. and Timpe et al. so as to increase the hydrophilicity of the cleaned substrate. With respect to claim 2 see column 7 line 19+ of Vermeersch et al. With respect to claims 3, 4 and 10 note the phosphoric acid of Timpe et al. With respect to claims 5, 7, 9, 11 - 13, 18, and 19 note column 4 lines 5 - 10 of Vermeersch et al. With respect to claims 6, 14 - 17, and 20 see column 3 lines 1 - 4 of Vermeersch et al.

Claims 8 and 21 - 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermeersch et al. in view of Nussel et al. and Timpe et al. as applied to the claims above, and further in view of Walls (US 4,351,895).

Neither Vermeersch et al. or Nussel et al. disclose the specific composition of the cleaning liquid. Walls teaches the conventionality of a cleaning liquid comprising an aqueous emulsion (column 2 lines 7 - 9) of an alcohol (column 2 lines 10 - 12) and a cyclic compound having at least one double bond (column 2 lines 13 - 22). It would have been obvious to one of ordinary skill in the art to provide the method of Vermeersch et al., as modified by Nussel et al. and Timpe et al., with a conventional cleaning liquid to remove the ink accepting areas without detrimentally affecting the substrate. See the Abstract of Walls.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See column 1 lines 48 - 52 and column 5 line 16 - 65 of Principato('493) and the Abstract and column 4 line 1 - column 5 line 51 of Telser et al. ('986).

Applicant's arguments filed November 13, 2003 have been fully considered but they are not persuasive for the reasons stated in the Advisory Action mailed October 27, 2003. The arguments with respect to claims 8 and 20 - 28 are moot in view of the new grounds of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen R. Funk whose telephone number is (703) 308-0982. The examiner can normally be reached from 7:30am to 6:00pm, except Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached on (703) 305-6619.

The fax phone number for ALL official papers is (703) 872-9306. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner at (703) 746-4393.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

SRF
December 29, 2003


STEPHEN R. FUNK
PRIMARY EXAMINER